



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,037	02/24/2004	Akira Sugiyama	60896 (70551)	3898
21874	7590	09/18/2007		
EDWARDS ANGELL PALMER & DODGE LLP				
P.O. BOX 55874				
BOSTON, MA 02205				
EXAMINER				
MOORE, KARLA A				
ART UNIT		PAPER NUMBER		
1763				
MAIL DATE		DELIVERY MODE		
09/18/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/787,037	SUGIYAMA, AKIRA	
	Examiner	Art Unit	
	Karla Moore	1763	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 7 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☒ Newly proposed or amended claim(s) 7 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 7.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-6 and 8-12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


KARLA MOORE
PRIMARY EXAMINER

Continuation of 11: does NOT place the application in condition for allowance because:

Regarding claim 1, Applicant argues that the disclosure of Okumura et al. does not teach or fairly suggest the provision of gas supplying means provided inside said first electrode and gas exhausting means provided inside said second electrode. Examiner disagrees. As pointed out in the final rejection, the disclosure of Okumura et al. discloses that gas flow mechanisms can be provided in either of the first and second electrodes of the disclosure and that either of the electrodes can house a gas supplying inlet or a gas exhausting outlet. See paragraphs 149 and 157. This fairly suggests the claimed recitation at issue. It would have been obvious to one of ordinary skill in the art that one of the electrodes could serve to house the inlet and the other could house the outlet. It is also noted that the courts have ruled that "the test of obviousness is not whether features of the secondary reference may be bodily incorporated into the primary reference's structure, nor whether the claimed invention is expressly suggested in any one or all of the references, rather the test is what the combined teachings would have suggested to those of ordinary skill in the art." *Ex parte Martin* 215 USPQ 543, 544 (PO Bd Pat App 1981). With respect to Applicant's further arguments regarding claim 1, it is noted that Koinuma et al. is relied upon for providing coated electrodes, not Okumura et al., as described in the final rejection. Examiner also disagrees that Okumura and the other relied upon references fail to teach or fairly suggest the gas supplying means having a supply opening formed in the first opposing surface and the gas exhausting means having an exhaust opening formed in said second opposing surface, although it is not illustratively depicted in the relied upon figures. The passages in the specification of Okumura et al. (e.g. paragraphs 149 and 157) disclose and/or fairly disclose such placement. It is also noted that the specific location of plasma generation is not recited in the pending claims, although Applicant appears to be arguing that this is a difference between the relied upon prior art and the disclosed invention.

Regarding claims 3-6, 8 and 11, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Regarding claim 9, Okumura et al. (along with the other relied upon art) fairly suggest the claimed invention. Further, the courts have ruled that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding Claim 10, as expressed above, Examiner disagrees with Applicant that Okumura fails to fairly suggest exhausting of the gas via the second electrode. Further, as pointed out in the final rejection, Yara et al. (at least) fairly teaches that specific relationships between the sizes of the electrodes and the distances between the electrodes and the object may be customized for specific applications and methods of using the apparatus.

Regarding claim 12, Applicant's arguments appear to be drawn to the polarity of the first, second and third electrodes, and such a feature(s) is not claimed.

Examiner maintains the positions of the previous office action. Unfortunately, Examiner did not have the time to call and schedule an interview and still timely mail this advisory action. If Applicant would like to schedule such an interview, Applicant is invited to call the Examiner for such a request.